

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Floran Prades, et al.	§ Customer No: 25264
Serial No.: 10/587,058	§ Group Art Unit: 1793
Confirmation No.: 8986	§
Filed: July 21, 2006	§ Examiner: JAMES A. CORNO JR.
For: Activating Supports for Metallocene Catalysis.	§ Attorney Docket No. F-891

PCT Legal Administration  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: PCT Legal Administration

## **PETITION TO THE DIRECTOR**

Appellants submit this Petition to the Director, responding to the decision of the Examiner of Group Art Unit 1793 dated July 01, 2009, finally rejecting Claims 23-42. This petition is filed in accordance with 37 C.F.R. § 1.181.

### Statement of the Facts

The Final Rejection states that the application was originally submitted as filed under 35 U.S.C. § 111(a). *See*, Final Rejection at page 2, Paragraph 2. The Final Rejection also states that since there was nothing in the papers present at filing indicating the case as a national stage filing, the application was not treated as a national stage application. *See*, Final Rejection at page 2, Paragraph 2.

According to the file wrapper history, no paper was filed positively indentifying the application as one under § 111(a). No paper filed by Applicant and listed in the image file wrapper makes any mention of § 111(a). Also, a Utility Patent Application Transmittal, form PTO/SB/05, has not been submitted. The only indication of whether the application is a regular non-provisional under § 111(a) or a § 371 national stage in the initial filing on 7/21/2006 is in the paper titled “Transmittal of New Application.” The Transmittal of New Application is addressed to “Mail Stop PCT” and refers to a “Transmittal Letter to the United States Designated/Elected Office (DO/EO/US).”

In addition, the first filed inventor’s declaration, filed on 10/24/2008, is addressed to “Mail Stop PCT”. The declaration also refers to the application as a national stage application in the following language of the declaration:

I believe I am an original, first, and joint inventor of the subject matter which is described and claimed and for which a patent is sought on the invention entitled Activating Supports for Metallocene Catalysis, the specification of which was filed July 21, 2006 and amended by a Preliminary Amendment filed July 21, 2006, as a national phase application of International Application No. PCT/EP2005/050235, with an international filing date of January 20, 2005, and having been assigned serial no. 10/587,058.

### Points to be Reviewed

According to MPEP § 1893.03(a), an examiner may treat an application as an application under § 111(a) if there is no indication in the originally filed application papers, or other evidence, that processing as a national stage (§ 371) is desired. In the current application, there are instances where Applicant has indicated the intention to file the application as a § 371 national stage in the originally filed application papers. For instance, the Express Mail Certificate of Mailing received by the USPTO on July 21, 2006 expressly referred to the USPTO as the “United States Designated/Elected Office (DO/EO/US).” Such a designation is used when referring to the office under a national stage application and is used in the title for a form PTO-1390. Form PTO-1390 is limited to transmittals concerning a 371 application. Thus, Applicant’s reference to the “Transmittal Letter to the United States Designated/Elected Office (DO/EO/US)” is an indication that the application was intended as a 371 national stage. In addition, The Transmittal of New Application was addressed to “Mail Stop PCT” on the first page, which was filed in the original filing on July 21, 2006.

The foregoing evidence indicates an intention to file the application as a national stage of a PCT. Therefore based upon the foregoing, the application should have been considered as a national stage application under 35 U.S.C. § 371.

The examiner argues that MPEP § 1893.03(a) states that:

[I]f there are any conflicting instructions as to whether the filing is under 35 U.S.C. § 111(a) or 35 U.S.C. § 371, the application will be accepted as filed under 35 U.S.C. § 111(a). A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. § 371, a “Utility Patent Application Transmittal” (Form PTO/SB/05) or includes a benefit claim under 35 U.S.C. § 120 to the internal application.

The Examiner maintains in this assertion that because the application was originally treated as filed under 35 U.S.C. § 111(a), under MPEP § 1893.03(a), any conflicting indication of the application being filed under 35 U.S.C. § 371 will have no

effect. However, a close reading of all the application papers as initially filed shows no indication was made by Applicant to file the application under 35 U.S.C. § 111(a). Applicant made no mention of § 111(a), did not include a Form PTO/SB/05, and included no benefit claim under 35 U.S.C. § 120 to the internal application in any of the papers of the initial filing. More importantly, Applicant made no positive indication or explicit instruction to file the application under 111(a). Therefore, there were no conflicting indications in the initial submission as to whether the filing was under 35 U.S.C. § 111(a) or 35 U.S.C. § 371.

In addition, under MPEP § 1893.03(a):

[I]f the applicant files a U.S. national application and clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Application Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application, then the application will be accepted as submitted under 35 U.S.C. § 371.

In the instant application, Applicant included an Inventor's Declaration signed by all four inventors, which states:

I believe I am an original, first, and joint inventor of the subject matter which is described and claimed and for which a patent is sought on the invention entitled Activating Supports for Metallocene Catalysis, the specification of which was filed July 21, 2006 and amended by a Preliminary Amendment filed July 21, 2006, as a national phase application of International Application No. PCT/EP2005/050235, with an international filing date of January 20, 2005, and having been assigned serial no. 10/587,058.

Thus, Applicant has met the requirements set out in MPEP § 1893.03(a), by clearly referring to a PCT application number (PCT/EP2005/050235) and international filing date (January 20, 2005) and clearly executing the declaration as the inventor of the

subject matter in the specification and stating that the subject matter is present in the national phase application.

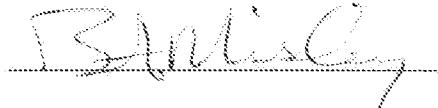
The Action Requested

In light of the foregoing evidence, Applicant maintains that the burden of proof set out in MPEP § 1893.03(a) has been met. Applicant, therefore, respectfully asks that the current application be treated as a 371 national stage application, having the appropriately claimed priority date. Applicant respectfully requests that the Director regard the present application as a 35 U.S.C. § 371 national stage application of PCT/EP2005/050235.

Respectfully submitted,

Date: September 17, 2009

By:



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